87-291

Supreme Court, U.S.
FILED
AUG 20 1987
JOSEPH F. SPANIOL, JR.
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No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

TERM 1987 - 1988

IN RE JAMES N. CONSTANT

PETITION FOR WRIT OF CERTIORARI
UNDER 28 U.S.C. 1651(a)
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

James Constant
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Pro se petitioner

QUESTIONS PRESENTED FOR REVIEW

1. Whether a change in a rule of practice by the Patent Office can remove a binding precedent established by a court of appeals.

2. Whether the Order of 17 June, 1987 (which designates publication of an unpublished opinion based on a change in a rule of practice by the Patent Office) is error absent the removal of a binding precedent established by a court of appeals.

3. Whether a binding precedent established by a court of appeals can be removed by a panel of that court through publication of an opinion based on a change in a rule of practice by the Patent Office.

4. Whether the Order of 17 June, 1987 is a violation of due process.

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The petitioner, James Constant respectfully prays that a writ of certiorari issue to review the order of the Court of Appeals for the Federal Circuit issued on 17 June, 1987.

OPINION BELOW

On 15 June, 1987, the Commissioner of Patents motioned the Court of Appeals for the Federal Circuit (CAFC) for publication of an unpublished opinion in Appeal No. 87-1012 attached as APPENDIX A. By Order of 17 June, 1987 attached as APPENDIX B, the court granted the Commissioner's motion.

JURISDICTION

This Court has jurisdiction under 28 U.S.C. Section 1651(a).

STATEMENT OF THE CASE

The Order of 17 June, 1987 EXHIBIT B was made before the time allowed by Rule 27 (a) of the Federal Rules of Appellate Procedure to make an opposition. Before receiving EXHIBIT B, on 19 June, 1987, the petitioner mailed his opposition to the Commissioner's motion. After receiving EXHIBIT B, on 20 June, 1987, the petitioner mailed his application to vacate that order. The published opinion was issued on 13 July, 1987. The court denied the petitioner's application on 16 July, 1987.

The relief sought is to vacate the Order of 17 June, 1987 EXHIBIT B on grounds the published opinion does not follow the binding precedent established by the predecessor court to the CAFC and on grounds it is a violation of due process as it was made before hearing the petitioner's opposition and application to vacate the order. Such relief is not available in any other court.

REASONS FOR GRANTING THE WRIT

The opinion in APPENDIX A should not be published because it does not look to the binding precedent established by the Court of Customs and Patent Appeals (CCPA).

The CAFC has adopted as binding precedent "the holdings of our predecessor courts" including the CCPA. South Corp. v. United States, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982). However, Chief Justice Markey stressed in a footnote that its broad adoption did not "affect the power of this court, sitting in banc, to overrule an earlier holding with appropriate explanation of the factors compelling removal of that holding as precedent". Id at 1370 n. 2. Therefore, where the Supreme Court has not spoken to an issue, the CAFC must look to decisions of the former CCPA for guidance.

The Manual of Patent Examining Procedure (MPEP) Section 1444 (5th ed., Rev. 2, Dec. 1985) was published after the date of the petitioner-appellant's notice of appeal to the Patent Office Board of Appeals (Board) and after the parties made their briefs to the Board (relevant docket nos 21-24). Thus, while the controlling law of case No. 87-1012 was and is established under MPEP 1414.03 discussed in In re Keller, 208 USPQ 871 (CCPA 1981), the case was decided under MPEP 1444 which is a change in the rules of practice. Mot. p. 2.

The opinion does not look to the binding precedent established in In re Keller for guidance. Nor does it look to the law under 35 USC 251 and 37 CFR 1.175 which the rules of practice implement. Rather, it looks to the change in the rules of practice, namely, from the prac-

tice under MPEP 1414.03 discussed in In re Keller to the new practice under MPEP 1444. However, absent a removal of the holding in In re Keller as binding precedent and absent a change in the law, the opinion must consider the case with reference to the practice existing at the time the petitioner-appellant made his appeal to the Board, e. g., the practice discussed in In re Keller.

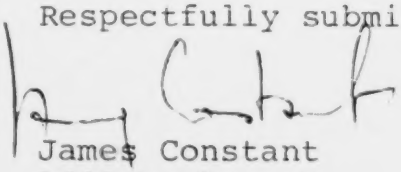
The order APPENDIX B should be vacated because the opinion in APPENDIX A does not look to the binding precedent in In re Keller which precedent has not been overruled by the CAFC, sitting in banc, "with appropriate explanation of the factors compelling the removal of that holding as precedent". Publication of the opinion would establish precedent by a change in the rules of practice rather

than by the binding precedent in In re Keller which stays in force until it is overruled by the CAFC sitting in banc.

CONCLUSION

The writ should be granted because a change in a rule of practice by the Patent Office cannot remove a binding precedent established by a Court of Appeals. The order of 17 June, 1987 is error absent the removal of the binding precedent in In re Keller by the CAFC sitting in banc. The manner in which the order was made violates due process.

Respectfully submitted



Date:

18 August, 1987

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Pro se petitioner

APPENDIX A

Note: This opinion will not be published in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE JAMES N. CONSTANT) Appeal No. 87-1012

DECIDED: April 13, 1987

Before BISSELL, Circuit Judge, BALDWIN, Senior Circuit Judge, and ARCHER, Circuit Judge.

BISSELL, Circuit Judge.

DECISION

The decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences (Board), Appeal No. 679-72: (1) affirming the Examiner's rejection of all the claims of the reissue application for failure to comply with the requirements of 37 C.F.R. 1.175 (1986); the regection of claims 1,74, 75,91,102,103,107,108 and 111 under 35 U. S.C. 251 (1982) as being prohibitively broader in scope than the original claims; the rejection of claims 33,47,58,71,89,100, 104,113 and 115 under the second paragraph of 35 U.S.C. 112 (1982); the rejection of claims 29-34, 43-46, 48, 54-57, 59, 67-70, 72-74, 85-88, 90, 96-99, 101, 102, 104, 105, 109, 112, 113 and 116-117 under the first paragraph of 35 U.S.C. 112; and (2) entering new grounds of rejection for

claims 2-5, 7-37, 39-64, 66-73, 76-90, 92-101, 104-106, 109, 110 and 112-117 under 35 U.S.C. 251 as being prohibitively broader than the original claims and claims 1-5, 7-34, 47, 58, 71, 75-90, 100, 103-113, and 115 as failing to satisfy the written description of the first paragraph of 35 U.S.C. 112 is affirmed.

DISCUSSION

Since the defective reissue declaration affects all the claims in the reissue application in this case, the rejection under 37 C.F.R. 1.175 is addressed first. Appellant argues that the Board erred in its construction of 37 C.F.R. 1.175(a)(3) by requiring appellant to specify every difference between the original and reissue claims. This argument is not persuasive. The Board's decision is based on rule 175 as a whole and not just rule 175(a)(3). Appellant's decla-

ration addressed only the excesses of the "signal processor" and failed to adress the remaining "excesses and insufficiencies" or how each of these errors arose. The Manual of Patent Examining Procedure Section 1444 (5th ed., Rev. 2, Dec. 1985) provides that "(e)very departure from the original patent represents an 'error' in said original patent under 35 U.S.C. 251 and must be particularly and distinctly specified and supported in the original, or a supplemental, reissue oath or declaration under (37 C.F.R. 1.175. Any changes in the specification or claims require an updated supplemental oath or declaration specifically directed and supporting said changes under (37 C.F.' R.) 1.175". Appellant has failed to show any error of law in the Board's application of the rule or in the rule's promulgation.

The remaining rejections are affirmed on the basis of the Board's opinion.

APPENDIX B

NOT TO BE PUBLISHED IN A REPORTER

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

IN RE JAMES N. CONSTANT	Appeal No. 87-1012
	ON MOTION

Before BISSELL, Circuit Judge, BALDWIN, Senior Circuit Judge, and ARCHER, Circuit Judge.

ORDER

Upon consideration of the Commissioner's MOTION UNDER FED. CIR. LOCAL RULE 18(c) FOR PUBLICATION OF AN UNPUBLISHED OPINION, IT IS ORDERED that the opinion in In re James N. Constant, Appeal No. 87-1012, be designated for publication.

FOR THE COURT

6/17/87

JEAN GALLOWAY BISSELL
Circuit Judge

Filed USCAFC 18 June, 1987

CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI UNDER 28 U.S.C. 1651(a) TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT was served on 18 August, 1987 by mailing first class a true and correct copy thereof addressed as follows:

Lee Barrett
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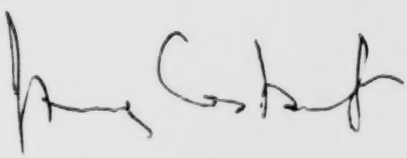

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